

Applicant : Sourabh Tewari
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REMARKS

Claims 1-18 were pending in the application. Claims 1, 2, 6-8, 11, and 14-18 have been amended. Claim 1 and claims 14-18 are independent. No new matter has been added. Reconsideration of the action mailed on July 28, 2004, is respectfully requested in view of the amendments to the claims and the following remarks.

Specification

The examiner objected to the title as not being descriptive. The applicant has amended the title.

The examiner objected to an informality in the specification, which has been corrected.

Section 102 Rejections

Claims 1-4, 6-7, 9-10, 15-16, and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. 6,336,124 ("Alam"). Claims 5 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Alam. Claims 8, 14 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Alam in view of Adobe Creative Team. Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Alam in view of U.S. 6,298,357 ("Wexler").

In rejecting claim 1, the Examiner asserts that Alam discloses a computer-implemented method for processing an electronic document. The Examiner further asserts, citing step 302 of figure 3, claim 1, and column 5, lines 10-15 of Alam, that the method disclosed in Alam includes obtaining a first electronic document containing logical elements having logical types and associated content with a visual appearance. The Examiner further asserts, citing claim 1 and column 6, lines 54-61 of Alam, that the method in Alam includes generating a second electronic document by associating marker attribute values with logical elements in the first document and converting the first document with a document conversion process that preserves the marker attribute values and the logical elements. Finally, the Examiner asserts, citing claim 1 and column 6, lines 54-61 of Alam, that the method disclosed in Alam includes using the marker attribute values to identify logical elements in the second electronic document. The cited passages of Alam actually read as follows:

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"A computer implemented method of converting a first document in a first document file format to a second document in a second document file format different from the first document file format, comprising:

locating first document file format data in the first document;

grouping said first document file format data into at least one intermediate document file format block in an intermediate document file format document, including locating words in the first document, joining words into lines, and joining lines into paragraphs, each paragraph being one of said intermediate format blocks;

locating tables, each table being one of said intermediate format blocks; and

converting said intermediate document file format document to the second document in the second document file format using said intermediate document file format blocks." [Alam, claim 1]

"The step of receiving input data may be achieved by receiving or reading data from a computer readable storage medium, such as those listed above, including CD-ROM, zip, floppy disk, tape, flash memory, system memory, hard drive, data signal embodied in a carrier wave." [Alam, column 5, lines 10-15].

"The intermediate format document preferably includes information including characters and their fonts (including italics), sizes, weights (bold or normal), underlines, and locations within a document. The intermediate format document preferably groups characters into words, lines, paragraphs, and/or tables. Each group is stored in the intermediate format document as an intermediate format block." [Alam, column 6, lines 54-61]

Nothing in the cited passages or figure, or anywhere else in Alam, indicates that a source document is modified by color-coding or marking the content (e.g., characters) of logical elements in the source document, where the marking is used to identify logical elements, as required by amended claim 1.

The examiner asserts that generating a second electronic document by converting the modified first electronic document with its marker attribute values is found in Alam at column 6, line 54-61. That passage refers to an intermediate format document that is created by a converter 628 that converts a PDF source format document into the intermediate format document. See column 6, lines 33-49. However, this source document in Alam is not modified in any way by the process, and in particular, it is not modified by the association of marker attribute values with content, as required by claim 1.

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Finally, although the intermediate format document of Alam might be seen as having marker attribute values, these cannot be the marker attribute values of claim 1, because the values in Alam were not provided by modifying the first document from which the second document was generated, as recited in claim 1.

In apparent inconsistency with the rejection of claim 1, the examiner rejects claim 2 by citing figure 6 of Alam, reading the third document of claim 2 on the PDF format document 626 and reading the second document of claim 2 on intermediate format document 530. An examination of figure 6 and the related text shows that there is no other document in the process going from the PDF document 626 (which the examiner acknowledges has no marker attribute values) and the intermediate document 530 (which the examiner asserts has the marker attribute values). Therefore, Alam does not teach or suggest a modified document from which is generated the intermediate document (corresponding to the second document, by the examiner's reading), or the method of generating and using such a document recited in claim 1.

For at least these reasons, claim 1 and its dependent claims are allowable.

The limitations of claim 16 correspond to those of claim 1. Claim 16 is therefore allowable for at least all the reasons that apply to claim 1.

Turning to claim 15, the examiner reads PDF document 626 (Alam, figure 6) as being the original final-format document recited in the claim. Therefore, the source document from which the final-format document was generated must be the document image 510 that was converted by program 612A into the final format (Alam, figure 6). However, claim 15 also requires that the source document have been generated by the same computer application that generated the final-format document. This is not taught or suggest by Alam, and in fact it is entirely contrary to the teaching and purpose of Alam.

For this additional reason, as well as the reasons set forth earlier in the remarks concerning claim 1, claim 15 is allowable.

The limitations of claim 18 correspond to those of claim 15. Claim 18 is therefore allowable for at least all the reasons that apply to claim 15.

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Section 103 Rejections

Claim 5 was rejected over Alam. Claim 5 depends from claim 1 and is allowable for at least all the reasons that apply to claim 1.

In addition, claim 5 recites that "the document conversion process is a print process." The examiner asserts that the converted document of claim 5 – referred to as the "second electronic document" in claim 1 – is the PDF format document 626 of Alam. The examiner further asserts, and correctly, that converting to a PDF document is well known as a type of print process. However, in the context of the process illustrated, for example, in figure 6 of Alam, there already is a printed document, namely documents 502 or 506, so the generating or conversion (claim 1) by a print process (claim 5) cannot legitimately be found in the process that generates PDF document 626 in Alam, especially inasmuch as the examiner also takes the inconsistent position that intermediate format document 530 is the generated second electronic document of the claim.

For these reasons, claim 5 should be allowed.

Claim 11 was rejected over Alam. Claim 11 depends from claim 1 and is allowable for at least all the reasons that apply to claim 1.

In addition, the examiner asserts that "the conversion process disclosed by Alam used marker attribute values to maintain logical types between documents." The examiner provides no citation to Alam to support that assertion. The examiner further asserts that Alam "inherently converts the marker attribute values to logical types to maintain the logical elements of the source documents." The resort to inherency is not supported.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

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The examiner has not met this standard. The examiner has not shown that "converting the marker attribute values to logical types", recited in claim 11, is "necessarily present", as required to establish inherency.

For at least the foregoing reasons, claim 11 is allowable.

Claims 8, 14, and 17 were rejected over Alam in view of Adobe Creative Team.

Claim 8 depends from claim 1, and is allowable for at least all the reasons that apply to claim 1.

Claims 14 and 17 have limitations corresponding to those of claim 8 and are allowable at least for reasons corresponding to those that apply to claim 8.

In addition, claims 14 and 17 recite that the color-coding of the source document is performed by the source computer program application, which application also produced the first PDF document and the color-coded, second PDF document. These features are not taught or suggested by Alam, either alone or in combination with Adobe Creative team.

Claims 14 and 17 are allowable for this additional reason as well.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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